Claims Not C mmensurate In Scope With Specification

It is error to confine applicants to only the specific embodiments finding "literal" support in the application. *In re Peters*, 221 USPQ 952, 953 (Fed. Cir. 1983) (reversing the United States Patent and Trademark Office (USPTO) Board of Appeals' rejection under §112 and §251 as erroneously confining applicant to the specific embodiment disclosed in the original patent). That claims may be broader than the specific embodiment disclosed in a specification does not mean they may not be allowed. *In re Rasmussen*, 211 USPQ 323 (CCPA 1981). The statutory provision for broadened claims in reissue applications (35 USC § 251) is intended to meet precisely this situation. *Id.* at 326.

Peters involved a denial of a reissue applicant's broadened claims. In reversing the denial, the Federal Circuit Court specifically disagreed with the Board's position that "because the reissue claims would encompass differing tip shapes, each such tip shape must be disclosed and described in the original disclosure before Peters may be given the benefit of §251." *Peters*, 221 USPQ at 953. The Board's hyper-technical construction of the patent statutes in *Peters* violated the inherency doctrine as well as the standard for the breadth of the disclosure.

Where the application's audience is the lay reader, the actual teaching would be limited to that which the disclosure contains in the specification and the drawings. However, applicants write to a skilled artisan, *In re Howath*, 210 USPQ 689, 691 (CCPA 1981). This reader merges his own knowledge of the art with the explicit teachings of the disclosure. It can only be by skill in the art that one is able to recognize features implicit or inherent to an invention. Otherwise, an applicant for patent would be unfairly limited solely to the specific embodiment literally disclosed in his specification. Such an absurd result contradicts both the controlling case law and the MPEP.

The USPTO's own patent examination procedure manual at MPEP § 706.03(d) prescribes a standard by which applicants' teaching includes what is known to one skilled in the art. Specifically, Form Paragraph 7.31.03 ("Rejection, 35 USC § 112, First Paragraph: Scope of Enablement") states that the Examiner must find that "the specification does not *enable any person skilled in the art* to which it pertains, or with which it is mostly nearly connected, to make or use the invention commensurate in scope with these claims." (Emphasis added).